

REMARKS

This application has been carefully reconsidered in view of the Office Action of July 20, 2005. By this amendment, claims 1-8, 18 and 22 have been cancelled and claim 19 has been amended to place it in independent form.

The rejection of the foregoing claims as unpatentable over WO 97/04871 in view of the patent to Apelian et al. is respectfully traversed. In view of the foregoing amendment, all of the claims in this case are now directed to the preferred embodiment of the invention in which the crystalline silicate catalyst is formulated with a silica binder prior to steaming and dealumination of the catalyst. As acknowledged in the Office Action, the primary reference does not disclose combining the crystalline silicate with a binder prior to the steaming procedure. To support the rejection of the claims, it is proposed to combine the disclosure in Apelian et al. with that of the primary reference in an attempt to arrive at applicants' invention. With respect to the proposed combination of references, it is noted that the basis for such combination under 35 U.S.C. § 103 must be found in the prior art references themselves and not in applicant's disclosure. It is respectfully submitted that the teachings of WO 97/04871 and Apelian et al. cannot be selectively combined in order to arrive at applicants' invention as claimed without a hindsight reconstruction of the prior art references, which could be made only after a reading of applicants' disclosure. The appropriate standard forbids using applicants' own disclosure as a basis for assembling prior art teachings and requires a suggestion or motivation in the prior art as reflected in decisions in *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 USPQ 929 (Fed. Cir. 1984) and *Ex parte Giles* 228 USPQ 886 (PTO Bd. Of Appeal. And Int. 1985). As expressed by the Board in *Giles* at 688:

Only appellant's disclosure and not the prior art provides a motive for achieving the combination as claimed by the appellant. To imbue one of ordinary skill in the art with knowledge of the invention . . .

when no prior art reference or references of record convey or suggests that knowledge is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

Attention is also respectfully invited to the Federal Circuit decision in *In re Fine*, 5 USPQ2d 1956 (Fed. Cir. 1988) wherein the Court stated at 1600:

It is essential that “the decisionmaker forget what he or she has been taught at trial about the claimed invention and cast the mind back to the time the invention was made . . . to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art.” *Id.* One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. (Emphasis added)

The admonitions in *Ex parte Giles* and *In re Fine* are to step back in time to evaluate the invention only in the context of what is disclosed in the references without regard to what is disclosed in applicant’s specification. When this is done, it is believed clear that one of ordinary skill in the art would not arrive at applicants’ invention based only upon the references and “the then-accepted wisdom in the art.” Only with the benefit of hindsight after a reading of applicants’ disclosure would it occur to one of ordinary skill in the art to attempt to combine the references to arrive at applicants’ invention.

Applicants’ invention, which is applied to the crystalline silicate catalyst formulated with the silica binder, involves the removal of aluminum from the crystalline silicate framework followed by treatment with the complexing agent to remove aluminum from the pores of the catalyst. The secondary reference, Apelian et al., is directed to selective surface dealumination and in this context, the secondary reference proposes that the catalyst can be formulated with the matrix material prior to or following the selective surface dealumination. The only suggestion of formulating the crystalline silicate catalyst with a silica binder prior to steaming to remove aluminum from the catalyst framework followed by extraction of aluminum from the pores of the

catalyst is found in applicants' specification, and not in the prior art references. If it were to occur to one of ordinary skill in the art to practice removal of aluminum from the catalyst framework rather than the selective surface dealumination of Apelian et al., and this is found in applicants' specification and not in the prior art references, the clear teaching of the references would be to practice the dealumination prior to the formulation of the catalyst with the binder. The only motivation to one of ordinary skill in the art to proceed in a fashion contrary to that taught in the prior art is clearly found only in applicants' specification, and not in the prior art references.

For the reasons advanced above, it is respectfully submitted that the claims as currently pending in this application are patentable over the prior art. Accordingly, an early reconsideration and allowance of this application is respectfully requested.

The Commissioner is authorized to charge any fee required in connection with the submission of this document to the Locke Liddell & Sapp LLP deposit account no. 12-1781.

Respectfully submitted,



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